

REMARKS

Claims 1-19 are pending. By this Amendment, claims 1, 2 and 5-16 are amended and claims 17-19 are added. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Claims 1-16 were rejected under 35 U.S.C. §112, first paragraph. The rejection is respectfully traversed.

The Office Action on page 2 alleges that the “specification fails to teach what the ‘agent capable of dissolving the polycrystalline’ is as well as the ‘counting method’ and the particle counter (7) for quantifying the foreign particles. The elements are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.”

MPEP §2164.04 states “In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.” It is respectfully submitted that the rejection is improper as the examiner has failed to meet the initial burden as the examiner’s determination that the specification fails to teach an agent capable of dissolving the polycrystalline silicon and that the counting method is incorrect. It is also respectfully submitted that the examiner’s determination that these elements are critical or essential the practice of the invention is incorrect.

Page 4, line 29, of the instant application clearly and unambiguously states “Examples of such an etchant include hydrofluoric and nitric acids.” The specification thus clearly teaches an agent capable of dissolving the polycrystalline silicon.

Page 5, lines 16-20, of the instant application clearly and unambiguously states “In addition, the composition of the foreign particles may be analyzed by using such methods as Scanning Electron Microscopy (SEM), or Energy Dispersive X-ray Spectroscopy (EDX). By using such analytical methods, not only the evaluation of the particle number but also the determination of the kind or origin of the particles may be carried out.” The specification thus clearly teaches the “counting method” and particle counter.

MPEP §2164.08(c) states “A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of the 35 U.S.C. 112.”

MPEP §2164.08(c) further states “In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical.” MPEP §2164.08(c) even further states “Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional

purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended.” It is respectfully noted that no limiting prior art exists.

The case cited by the examiner, In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) is inapposite to the instant application. Mayhew involved an application in which the only disclosed mode of operation involved the use of a cooling zone at a particular location. Applicants have disclosed at least two agents and at least two counting/analyzing methods.

Page 4, lines 27-28, of the instant application clearly and unambiguously states “The kind of etchant 3 used in this embodiment is not particularly limited as long as it is capable of dissolving the polycrystalline pieces 1.” As discussed above, page 5, lines 16-18 of the instant application “the composition of the foreign particles may be analyzed by using such methods as Scanning Electron Microscopy (SEM), or Energy Dispersive X-ray Spectroscopy (EDX).” (Emphasis added.) Accordingly, the examiner’s determination that the “these elements are critical or essential to the practice of the invention” is clearly incorrect.

Claims 2-19 are also fully enabled by the specification.

Reconsideration and withdrawal of the rejections claims 1-16 under 35 U.S.C. §112, first paragraph are respectfully requested.

Claims 1-16 were rejected under 35 U.S.C. §112, second paragraph. The rejection is respectfully traversed.

The Office Action on page 2 states “the claims are vague and indefinite as to what the ‘agent’ is and how the foreign particles are counted/analyzed.”

35 U.S.C. §112, second paragraph states “the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” (Emphasis added.)

35 U.S.C. §112, second paragraph requires the applicant, not the examiner, to particularly point out and distinctly claim the subject matter regarded as the invention. Claim 1 recites an evaluation method for polycrystalline silicon, including immersing the polycrystalline silicon in an agent which is capable of dissolving the polycrystalline silicon and counting the number of foreign particles in the agent. Claim 1 particularly points out and distinctly claims the subject matter Applicants regard as their invention.

Claim 1 does not specify an exact agent capable of dissolving the polycrystalline silicon because Applicants do not consider their invention to be limited to an exact agent or agents capable of dissolving the polycrystalline silicon. As discussed above, Applicants have

clearly stated this on page 4, lines 27-28, of their specification. In addition, claim 1 does not specify the exact manner in which the number of foreign particles in the agent are counted as Applicants do not consider their invention to be limited to the exact manner of counting the number of foreign particles in the agent. As discussed above, Applicants have clearly provided two examples on page 5, lines 16-20, of evaluating the particle number.

Claims 2-19 particularly point out and distinctly claim other subject matter Applicants regard as their invention and fully comply with the requirements of 35 U.S.C. §112, second paragraph.

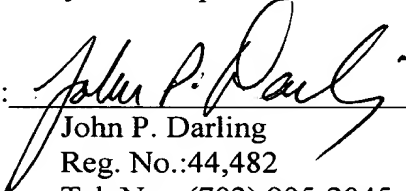
Reconsideration and withdrawal of the rejection of claims 1-16 under 35 U.S.C. §112, second paragraph are respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all of the claims are allowable and that the entire application is in condition for allowance.

Should the examiner believe that anything further is desirable to place the application in better condition for allowance, the examiner is invited to contact the undersigned at the telephone number listed.

Respectfully submitted,

Pillsbury Winthrop LLP

By: 
John P. Darling
Reg. No.: 44,482
Tel. No.: (703) 905-2045
Fax No.: (703) 905-2500

JPD\tmt

P.O. Box 10500
McLean, VA 22102

(703) 905-2000